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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,806	09/25/2001	Reid Evan Wilson	1014-004US01	1202
28863	7590	03/23/2006	EXAMINER	
SHUMAKER & SIEFFERT, P. A. 8425 SEASONS PARKWAY SUITE 105 ST. PAUL, MN 55125			CHANKONG, DOHM	
			ART UNIT	PAPER NUMBER
			2152	

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/963,806	Applicant(s) WILSON ET AL.	
	Examiner Dohm Chankong	Art Unit 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 12, 14-18, 20-30, 32-36, 38, 40-47 and 50-66 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-18, 43, 58-63 and 66 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, 11, 13-15, 20-24, 26-30, 32, 33, 38, 40-42, 44-47, 50-57, 64 and 65 is/are rejected.
- 7) ☒ Claim(s) 6, 12, 25, 30 and 34-36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1> This action is in response to Applicant's request for continued examination. Claims 1-9, 11, 12, 14-18, 20-30, 32-36, 38, 40-47 and 50-66 are presented for further examination.

2> Please note that this application is now being considered by a new examiner.

3> This is a non-final rejection.

Allowable Subject Matter

4> Claims 16-18, 43, 58-63 and 66 are allowed.

5> Claims 34-36 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.

6> Claims 6, 12, 25 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of the reason for the indication of allowable subject matter: the functionality of submitting an xml-tagged address is novel. This limitation is distinguished over the more general "self-describing" or "format describing a type of the output" terminology used in the other, non-allowed claims. One of ordinary skill in the art would interpret a numeric address, generally formatted as X.X.X.X , as in a format that

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describes itself as an address and therefore is not patentability distinct. However, the use of XML-tagging for the address more specifically defines the manner which the request is "self-describing", is distinct from the prior art, and therefore, is indicated as allowable.

Response to Arguments

7> The indicated allowability of dependent claims, now incorporated into claims 1, 11, 20, 29, 38, 44, 46, 47, 50, 51, 52, 64, and 65, cited in the Final Rejection, filed 6.30.2005, is withdrawn in light of newly discovered prior art. Rejections based on the prior art follow.

8> The 35 U.S.C § 101 rejections of claims 20, 29, and 34 are maintained. The Office maintains that a claim that can be read so broadly as to include both statutory or non-statutory subject matter must be amended to limit the claim to a practical application. In other words, if the claim does not require a practical application, it must be rejected.

Possible amendments include limiting the claims to practical and tangible embodiments or amending the specification by eliminating the references to the non-tangible embodiments [such as "modulated carrier wave"].

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9> Claims 1, 11, 16, 20, 24, 29, 34, 38, 43, 44, 46, 47, 50, 51, 52, 58 and 64-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 1 is rejected for being vague and indefinite and not clearly defining what Applicant believes to be his invention. Claim 1 discloses functionality for "receiving output from a router", "querying a server" and "invoking a CLI"; it is unclear from the claims what device is actually performing the receiving, querying or invoking steps. As an example, it is clear that the output is "from a router" and the response is "from a server" and directed to "a user". Examiner believes that such clarifying language is necessary and would be helpful in the other steps to more clearly define the claimed invention.

b. All other claims are rejected for similar reasons.

Claim Rejections - 35 USC § 101

10> 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11> Claim 20, 29, and 34 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 20, 29, and 34 are not limited to tangible embodiments. In view of Applicant's disclosure, specification page 5, line 1-15, the computer readable medium (e.g. processor readable medium) is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., computer storage media)

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and intangible embodiments (e.g., modulated data signal, such as a carrier wave). As such, the claim is not limited to statutory subject matter and is therefore non-statutory. A computer readable medium having instructions thereon which when executed perform the steps of a useful method would normally be considered statutory unless the specification defines "computer readable medium" as including intangible media such as signals, carrier waves, transmissions, optical waves, transmission media or other media incapable of being touched or perceived absent the tangible medium through which they are conveyed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12> Claims 1-4, 20-23, 38, 40, 41, 47, 50, 51, 52, 64 and 65 are rejected under 35 U.S.C § 103(a) as being unpatentable over Bellovin et al, U.S Patent No. 5,958,052 ["Bellovin"] in view of Wilson et al, U.S Patent No. 2002|0009078 ["Wilson"].

13> Bellovin is directed towards a system for resolving a request containing an address to a domain name utilizing a name server [column 4 «lines 10-40»].

14> Wilson is directed towards a device that specially designed to provide services to network users. The device is designed be to be placed between users and the internet much like a router [see for example, Figure 7]. The device, utilizing a command line interface, directs communications, such as address requests, from users to appropriate servers to service the requests [for example, 0101].

15> As to claim 1, Bellovin discloses a method comprising:

receiving output from a router system module in a format describing a type of the output [column 4 «lines 35-40» where : Bellovin discloses the output is in a format of an address. The request, essentially, describes itself as an address.];

querying a server selected as a function of the type of the output [column 4 «lines 59-67»]; and

providing a response from the server to a user [column 4 «lines 59-67» | column 6 «lines 40-58»].

Bellovin does not expressly disclose utilizing a command line interface.

16> Wilson discloses utilizing a command line interface to query a server [Figure 14 «item 807» | 0228-0230]. It would have been obvious to one of ordinary skill in the art to modify Bellovin's DNS proxy [Figure 10] to include the command line interface daemon as taught by Wilson. Wilson's command line interface daemon improves Bellovin's system by providing additional functionality, such as serving as a user interface for providing address|name mappings [see Wilson, 0390-0395].

17> As to claim 2, Bellovin discloses the output as a numeric address [column 4 «lines 35-40»].

18> As to claim 3, Bellovin discloses the method of claim 2, further comprising:
querying a name server selected as function of the type of the output [column 4 «lines 10-26» where : “get-name” request];

receiving from the name server a symbolic name associated with the numeric address
[column 4 «lines 10-40» : “get-name” request returns a name]; and

providing the symbolic name as the response to the user [column 5 «lines 1-6»].

19> As to claim 4, Bellovin discloses the method of claim 2, further comprising:
querying an owner database selected as function of the type of the output [column 3
«lines 23-38» | column 4 «lines 10-26» where : “get-name” request];

receiving from the owner database an identification of an owner associated with the
numeric address [column 4 «lines 10-40» : “get-name” request returns a name]; and

providing the identification of the owner as the response to the user [column 5 «lines 1-6»].

20> As to claims 20-23, 38, 40, 41, 50, 51, 52, 64, 65, as they do not teach or further define
over the previously claimed limitations, they are rejected for at least the same reasons as set
forth for claims 1-4.

21> As to claims 47, Bellovin discloses the limitations previously rejected in claim 1.

Bellovin also discloses the system module including a firewall filter module [Figure 7 «item 402»],.

22> Claims 7, 8, 11, 14, 15, 26, 27, 29, 32, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bellovin and Wilson, in view of Tan et al., U.S Patent No. 6,314,469 [“Tan”].

23> In regards to claim 7,8, 26 and 27, Bellovin discloses the method of claim 1 and processor readable medium of claim 20 which comprises a plurality of network components, see above.

Bellovin is silent on rendering the output in a text format different from the format describing a type of the output before querying the server; wherein the text format is selected from the group consisting of ASCII format, a UTF format and a Unicode.

Tan discloses an network component (16) for rendering output in a text format different from the format describing the type of output which is selected from the said group (e.g. Unicode, ASCII) before querying the server (e.g. name server-18).

It would be obvious to one of ordinary skill in the art at the time of the invention to modify Bellovin by having that which is taught by Tan above in order to convert text into a format that a name server can use thus enabling users to user to send non-Unicode and non-ASCII encoded requests (abs, col. 2 ll. 55-59c. 9 ll. 53-62).

24> As to claims 11, 14, 29, 32, 44 and 45, as they do not teach or further define over the previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claims 1, 7, and 8.

25> As to claim 15, Bellovin discloses numeric address identifies a network peer [column 3 «lines 39-50»].

26> Claims 9, 28 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bellovin and Wilson, in view of Pabla, U.S Patent Publication 2002/0156875.

27> Bellovin discloses the methods of claim 1 and programmable readable medium of claim 20 for executing said methods.

Pabla discloses a peer (e.g. the proxy of Bellovin) which initiates a discovery on a Peer Name Server (e.g. a component of Bellovin's network, See Pabla [0042]). The Peer Name server in response provides a list of peer names (e.g. a reverse lookup capability disclosed by Pablo [0049], hence the output from said peer to said peer name server is a list of numeric address of network peers.) [0042][0049][0059][0060][0089][0100][0101]

It would be obvious to one of ordinary skill in the art at the time of the invention to modify Bellovin by having output comprising a listing of network peers identified by numeric address, as taught by Pablo in order to reduce the load on server systems by allowing peers to bypass the server for information, file exchange and other resource sharing, allowing the

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servers to perform services which require the specialized hardware and/or software of a "dedicated" server system [060][0010].

28> As to claim 46, as it does not teach or further define over the previously claimed limitations, it is similarly rejected for at least the same reasons set forth for claim 9.

Conclusion

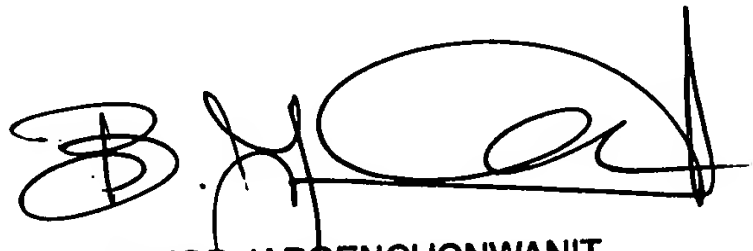
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942.

The examiner can normally be reached on Monday-Thursday [7:00 AM to 5:00 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DC



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